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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 24

Application Number: 10/004,511
Filing Date: October 22, 2001
Appellant(s): MORRIS, SHANNON

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GROUP 3700

Gary A. Clark
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/9/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct. However, the Examiner hereby withdraws the rejection of claims 8-11 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Frost (2,036,572).

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 8-11 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,040,681

GRUSIN

8-1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 8-11 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Grusin (5,040,681). Grusin discloses a cover/organizer (18) comprising a body (32) having an upper surface and a lower surface, a knob (50) protruding upwardly from the body and extending above the upper surface, at least one compartment (34) formed in the upper surface of the body and a recess in the lower surface of the body. The knob of Grusin is inherently capable of receiving at least one finger ring over the knob (Figures 1-5). As to claims 9 and 10, Grusin discloses an outer rim (extending downwardly in Figure 4) includes a lip around the periphery of the body.

(11) Response to Argument

(A)

Appellant's arguments with respect to Grusin on page 4 of the brief are noted. They are not persuasive because the diameter and height of the knob of Grusin is inherently capable of receiving the at least one finger ring over the knob since the at least one finger ring can be of various sizes. The knob of Grusin is inherently capable of receiving an oversized finger ring over the knob. Furthermore, Grusin discloses the knob comprises a planar top surface. The

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knob of Grusin is inherently capable of receiving the at least one finger ring over the knob on the planar top surface since the claim as broadly recited read on the at least one finger ring placed on the planar top surface of the knob/over the knob. (the word [over] is defined as In or at a position above or higher than; Upon the surface of; Above the top or surface; ... (WEBSTER'S II New Riverside University Dictionary; Property of U.S. Government; Copyright 1984, 1988, 1994 by Houghton Mifflin Company)).

Appellant argues that "Grusin teaches away from sizing his knob 30 to receive a finger ring ..." on page 4 of the brief is noted. This is not persuasive because the knob is inherently capable of receiving an oversized finger ring over the knob and the planar top surface of the knob is inherently capable of receiving the at least one finger ring over the knob.

Appellant's arguments with respect to Grusin on page 5 of the brief are noted. They are also not persuasive because the intended use of the claimed invention i.e. capable of receiving at least one finger ring over the knob, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

(B)

Appellant's arguments with respect to Frost on pages 6 and 7 of the brief are noted. After being carefully reconsidered, the Examiner hereby withdraws the rejection of claims 8-11 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Frost (2,036,572).

(C)

The Examiner is attached a complete copy of the appeal claims of S/N 08/766,862 in the Appendix.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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February 4, 2004

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